

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-5, 9, 13, 16-34, and 36-59 are pending in the application, with claims 1, 5, 9, 13, 19, 34, 39, 44, 51, 58, and 59 being the independent claims. Claim 35 is sought to be canceled without prejudice to or disclaimer of the subject matter recited therein. Claims 1-5, 9, 13, 16-19, 22, 23, 30-34, and 36-43 are sought to be amended. With respect to the canceled and amended claims, Applicant reserves the right to prosecute similar or broader claims in the future. New claims 44-59 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

**Telephonic Interview**

Applicant and Applicant's representative wish to thank Examiner Larry D. Donaghue for the telephonic interview with the Applicant's representative, Mr. Timothy A. Doyle, on April 2, 2009. During the interview, Applicant's representative and the Examiner discussed proposed amendments to the claims and proposed new claims. An agreement was not reached.

However, the Examiner did agree, in the event that he determines that some of the claims are allowable, to contact Applicant's representative to discuss the possibility of placing the patent application in a condition for allowance via an Examiner's Amendment Under 37 C.F.R. § 1.121(g).

**Rejection Under 35 U.S.C. § 101**

The Examiner, at page 2 of the Office Action, rejected claims 13, 16-18, and 34-38 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Without conceding the propriety of the rejection, and solely to advance prosecution to issue, Applicant respectfully submits pending claims 13, 16-18, and 34-38 overcome the rejection under 35 U.S.C. § 101. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 13, 16-18, and 34-38 under 35 U.S.C. § 101.

**Rejection Under 35 U.S.C. § 103**

***Pepe in View of Mizikovsky, Owens, and Scannell***

The Examiner, at page 2 of the Office Action, rejected claims 1-5, 9, 13, and 16-43 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. No. 5,742,905 to Pepe *et al.* ("Pepe") in view of U.S. Patent No. 5,559,860 to Mizikovsky ("Mizikovsky"), U.S. Patent No. 6,633,630 to Owens *et al.* ("Owens"), and U.S. Patent No. 5,377,354 to Scannell *et al.* ("Scannell").

Regarding claim 35, Applicant has canceled this claim without prejudice to or disclaimer of the subject matter recited therein, thereby rendering the rejection of this claim moot.

Regarding claims 1-5, 9, 13, 16-34, and 36-43, Applicant respectfully traverses the rejection of these claims. Claim 1 recites features that distinguish it from the applied references. For example, claim 1 recites, "wherein the first characteristic is located in attachments of the e-mail messages[.]" None of Pepe, Mizikovsky, Owens, and Scannell, alone or in combination, discloses, teaches, or suggests at least the above-noted distinguishing features.

The Examiner concedes, at page 3 of the Office Action, that "[n]one of the previously cited references [Pepe, Mizikovsky, and Owens] taught the characteristic being located in the e-mail message in the body or the attachment." With regards to at least "wherein the first characteristic is located in attachments of the e-mail messages[.]" Scannell was not used by the Examiner to teach at least the above-noted distinguishing features, nor does Scannell overcome the deficiencies of Pepe, Mizikovsky, and Owens with respect to at least the above-noted distinguishing features. Therefore, claim 1 is patentable over Pepe in view of Mizikovsky, Owens, and Scannell.

Each of independent claims 5, 9, 13, 19, 34, and 39 recites, using respective language, features similar to at least the above-noted distinguishing features. Accordingly, each of independent claims 5, 9, 13, 19, 34, and 39 is also patentable over Pepe in view of Mizikovsky, Owens, and Scannell.

Furthermore, because each of claims 2-4, 16-18, 20-33, 36-38, and 40-43 depends upon claims 1, 5, 9, 13, 19, 34, or 39 and because of the individual distinctive features of each of claims 2-4, 16-18, 20-33, 36-38, and 40-43, each of these claims is also patentable over Pepe in view of Mizikovsky, Owens, and Scannell.

Therefore, Applicant respectfully requests that the Examiner reconsider the rejection of claims 1-5, 9, 13, 16-34, and 36-43, withdraw the rejection of these claims under 35 U.S.C. § 103(a), and pass these claims to allowance.

***Pepe in View of Mizikovsky, Owens, and Scannell, and in Further View of Fuller***

The Examiner, at page 8 of the Office Action, rejected claims 3 and 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Pepe in view of Mizikovsky, Owens, and Scannell, and in further view of U.S. Pat. No. 6,545,589 to Fuller *et al.* ("Fuller"). Applicant respectfully traverses the rejection of these claims.

Each of claims 3 and 18 depends upon claim 1 or 13. As explained above, none of Pepe, Mizikovsky, Owens, or Scannell, alone or in combination, discloses, teaches, or suggests at least the above-noted distinguishing features. Fuller was not used by the Examiner to teach at least the above-noted distinguishing features and Fuller does not overcome the deficiencies of Pepe, Mizikovsky, Owens, and Scannell with respect to at least the above-noted distinguishing features. Accordingly, each of claims 1 and 13 is patentable over Pepe in view of Mizikovsky, Owens, and Scannell, and in further view of Fuller.

Because each of claims 3 and 18 depends upon claim 1 or 13 and because of the individual distinctive features of each of claims 3 and 18, each of these claims is also patentable over Pepe in view of Mizikovsky, Owens, and Scannell, and in further view of Fuller. Therefore, Applicant respectfully requests that the Examiner reconsider the rejection of claims 3 and 18, withdraw the rejection of these claims under 35 U.S.C. § 103(a), and pass these claims to allowance.

### **New Claims**

Applicant has added new claims 44-59. Support for the features recited in claims 44-59 can be found throughout the specification of the patent application including, by way of example and without limitation, at Figures 1A, 1B, and 2. New claims 44-50, 58, and 59 are allowable over the references of record because the references of record do not disclose, teach, or suggest at least the features recited in claim 44 of (emphasis added):

producing, using the processing device, a copy of the original e-mail message;

*forwarding*, using the processing device, *the original* e-mail message to an e-mail address of a recipient of the original e-mail message; [and]

*analyzing*, using the processing device, *the copy* to determine if a content of the copy matches a criterion stored in the memory[.]

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New claims 51-57 are allowable over the references of record because the references of record do not disclose, teach, or suggest at least the features recited in claim 51 of (emphasis added):

produce a copy of the original e-mail message,  
***forward the original*** e-mail message to an e-mail address of a recipient  
of the original e-mail message, [and]  
***analyze the copy*** to determine if a content of the copy matches a  
criterion[.]

Accordingly, Applicant respectfully requests that new claims 44-59 be passed to allowance.

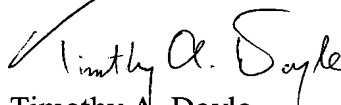
***Conclusion***

All of the stated grounds of rejection have been properly traversed or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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